

## **REMARKS**

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicant originally submitted Claims 1-4 in the application. The Applicant has amended Claims 1-4 and added Claims 5-6. Support for the amendments to Claims 1-4 and new Claims 5-6 includes, e.g., page 8, line 1 to page 11, line 17 and Figures 5 and 6 of the specification.

Accordingly, Claims 1-6 are currently pending in the application.

### **I. Formal Matters and Objections**

The Examiner has objected to the listing of references in the specification as not being a proper information disclosure statement. While the Applicant makes no statement as to the pertinence of these references to the patentability of the pending claims, the Applicant takes the Examiner's statement as suggesting that he thinks that the reference may be pertinent and has had every opportunity to examine these references. However, to ensure consideration of these references, the Applicant submits an information disclosure statement presenting these references in form PTO-892 with this response.

The Examiner has objected to the specification as having too long an abstract and presenting the serial number of a referenced patent application listed in the specification. In response, the Applicant has amended the Abstract, and, provided the serial numbers of the referenced patent application in the specification.

The Examiner has objected to Claim 2. In response, the Applicant has amended the claim.

## **II. Rejection of Claims 1-4 under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response, the Applicants have amended Claims 1-4 to comply with 35 U.S.C. §112, second paragraph. Accordingly, the Applicants respectfully request the Examiner to withdraw the §112, second paragraph rejection of Claims 1-4 and allow issuance thereof.

## **III. Rejection of Claims 1-4 under 35 U.S.C. §102**

The Examiner has rejected Claims 1-4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,538,823 to Kroupenkine *et al.* ("Kroupenkine"). The Examiner has also rejected Claims 1-4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,665,127 to Bao *et al.* ("Bao"). The Examiner has also rejected Claims 1-4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,369,954 to Berge *et al.* ("Berge").

### Kroupenkine and Bao

Concerning the rejections based on Kroupenkine or Bao, as noted by the Examiner:

This rejection under 35 U.S.C. 102(e) might be overcome by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. (Detailed Action, Page 5, Lines 2-5)

In response, the Applicant submits along with this response an affidavit under 37 CFR 132 by Thomas Nikita Krupenkin, attesting that he is the same "Timofei Nikita Krupenkine" as listed as an inventor in Kroupenkine and in Bao.

Therefore the Applicant requests the Examiner to withdraw the 102(e) rejections of claims

1-4 based on these references.

Berge

The Applicant respectfully submits that the relied upon portions of Berge do not teach all of the elements of the pending claims. In particular, Claim 1 recites, among other things "returning a droplet of conducting liquid of a tunable liquid microlens to a calibration position."

In contrast, Berge teaches that his droplet is electrically insulating (see Abstract) which is the opposite of what is recited in Claim 1. Therefore, the Office Action has not shown that Berge discloses each and every element of the claimed invention and as such, has not shown that Berge is an anticipating reference.

Because Claims 2-6 are dependent upon Claim 1, as applied in the Office Action, Berge is not an anticipating reference for these claims.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the §102(e) rejection with respect to the Claims.

**IV. Double Patenting Rejection**

The Examiner asserts a non-statutory double patenting rejection against Claim 1-4 based on Claim 1-4 of the Patent No. 7,006,299 (Kroupenkine-2).

In response, the Applicant respectfully disagree that Claims 1-4 of Kroupenkine-2 recites or make obvious the combinations of features in any of pending Claims 1-4.

For instance, while pending Claim 1 recites "the first set of electrodes and the second set of electrode lay in a different lateral planes relative to the droplet," Claims 1-4 of Kroupenkine-2 do not recite or suggest such a limitation. For that reason, claim 1 of the present application is non-

obvious over claims 1-4 of Kroupenkine-2.

Therefore the Applicant respectfully requests the Examiner to withdraw the double patenting rejection with respect to the Claims.

**V. Conclusion**

In view of the foregoing amendment and remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a timely Notice of Allowance for Claims 1-6.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Ronald J. Corbett", with a stylized flourish at the end.

Ronald J. Corbett  
Registration No. 47,500

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P.O. Box 832570  
Richardson, Texas 75083  
(972) 480-8800